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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,917	03/25/2002	Hidetatsu Murakami	1155-0246P	2681

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EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,917

Applicant(s)

MURAKAMI ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1,3,7-12 and 15 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 6-8, 11-14 and 16-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it is too long and because it exceeds a single page. Correction is required. See MPEP § 608.01(b).

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

### ***Claim Objections***

2. Claims 2, 4, and 6 are objected to because of the following informalities: Designations (C-1) and (D-1) are superfluous and do not contribute significance with respect to the pre-existing labeling scheme of the present claims. Therefore, they may be deleted. Appropriate correction is required.
3. Claims 2, 4, and 6 are objected to because of the following informalities: Remove the word "further" since the properties are already recited in the parent claim.
4. Claims 7 and 8 are objected to because of the following informalities: Rewrite the inequalities without use of "x x." A coefficient written adjacent to a variable implies a multiplication function, and this designation is understood universally. Appropriate correction is required.

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5. Claims 11 and 12 are objected to because of the following informalities: Remove “relational.” A mathematical expression describes a relation between two variables. Therefore, the term is redundant.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The meaning of the claim is not understood, and it appears to be a result of inadequate translation. Elucidation or revision of claim language is strongly suggested.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 3, and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,444,773 to Markel.

Markel discloses an ethylene/ $\alpha$ -olefin copolymer that has a vinyl content of 0.01 vinyl groups/1000 C and no vinylidene groups (Example 19c). The molecular weight distribution is 2.120. The density and melt index is not disclosed. However, in view of the low molecular weight and in view of the fact that the claimed melt index spans seven orders of magnitude, the skilled artisan would find it obvious to believe that the copolymer described in Markel also have comparable density and MI. Also, one having skill in the art would have sufficient basis to believe that  $^{13}\text{C}$  NMR and rheological analyses of the polymer of Markel would reveal the recited properties since materials which are essentially the same will exhibit essentially the same

physical properties. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

***Allowable Subject Matter***

11. The following is a statement of reasons for the indication of allowable subject matter: Claim 5 is allowed over Markel because the reference does not teach ethylene/ $\alpha$ -olefin/cycloolefin terpolymers.

12. Claim 6 would be allowed if rewritten to overcome the claim objection set forth in this office action.

13. Claims 2 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome claim objections and if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 13, 14, and 16-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims

The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure. The following references teach ethylene/ $\alpha$ -olefin copolymers with specific vinyl and vinylidene content. These are cited to show the state of the art with respect to such copolymers.

U.S. Patent No. 5,096,955 to Johnston *et al.*

U.S. Patent No. 4,988,783 to Beran *et al.*

U.S. Patent No. 3,981,849 to Frese *et al.*


JP 11-060632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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July 1, 2003

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700